

## REMARKS/ARGUMENTS

### 1. *Status of the Claims*

Claims 1-20 are pending in the application.

Claims 1-17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Afriat et al. (US 6,203,576) in view of Davidson (US 5,180,394). Claim 18 is objected to as being dependent upon a rejected base claim. Applicant respectfully traverses the rejection and requests reconsideration.

Claim 10 has been amended.

### 2. *Obviousness Rejection - Afriat et al. (US 6,203,576) in view of Davidson (US 5,180,394).*

Obviousness can be established by combining features of references only if there is teaching in the prior art references, see *In Re Donaldson*, 16 F.3d 1189, 1193-94 (Fed. Cir. 1994), supporting such a combination. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992); *Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 140 (Fed. Cir. 1986). To be combinable, references must suggest the advantages achieved by the invention, and must lead the person of ordinary skill in the art to expect to obtain those advantages by combining the references. *In re Sernaker*, 702 F.2d 989, 994 (Fed. Cir. 1983). It is insufficient that one skilled in the art might find it "obvious to try" combining the prior references. *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987). The obviousness standard requires that one skilled in the art can look at the prior art references and combine them into the patent as the patentee filed it. *Motorola, Inc. v. Interdigital Technology Corp.*, 121 F.3d 1461, 1471 (Fed. Cir. 1997).

Neither the Davidson reference, nor the Afriat reference alone, or in combination teach the use of a diffusion-hardened coating in contact zones where repeated stressful contact occurs between two separate components of a prosthetic device. Instead, Davidson addresses that "[t]he zirconium oxide or nitride coating provides the invention prosthesis with a thing, dense, low friction, wear resistant, biocompatible surface ideally suited for use on articulating surfaces of joint prostheses wherein a surface or surfaces articulates, translates or rotates against mating joint surfaces." See Davidson, col. 5, lns. 14-20).

As discussed in paragraph 11 of the Application, the quick flexion motion of the knee will cause the post of the tibial insert to abruptly contact the horizontal cam. In addition, to wear placed upon the central post, repeated stressful contact from the central post to the horizontal cam may cause undue cam fatigue ultimately leading to cam deformation or failure. The inventors have determined that a suitable diffusion-hardened surface along the cam at the contact interface between the cam and the post of a polymeric insert cause will reduce undue cam fatigue and cam deformation or failure.

The holding in *In re Royka*, 490 F.2d 981 (CCPA 1974) states that all of the claim limitations must be taught or suggested by the prior art. Independent claim 1 (and dependent claims) requires that "the cam having a diffusion-hardened surface along a portion of the cam for adding strength and wear resistance to the contact zones of the cam." Independent claim 10, as amended, requires that the non-load bearing surface have a diffusion-hardened surface "along a portion of its length for adding strength to areas where the second load bearing surface impacts the non-load bearing surface." Independent claim 16 (and dependent claims) requires that "the cam having a having diffusion-hardened surface along a portion of its length for adding strength to the impact zones of the cam."

The Davidson reference does not teach utilizing a diffusion hardened surface for adding strength to impact or contact zones of two components of a prosthetic. The Action impermissibly tries to add undisclosed features to independent claims 1, 10 and 16 by concluding that it would have been obvious to one of ordinary skill in the art to add these elements. However, neither reference alone, nor in combination teaches these requirements.

### **3. Conclusion**

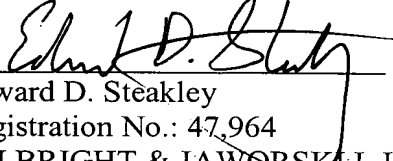
Applicant respectfully requests withdrawal of the rejection to claims 1-17 and 19-20 based on the obviousness rejection - Afriat et al. (US 6,203,576) in view of Davidson (US 5,180,394).

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P02368US0 from which the undersigned is authorized to draw.

Dated: November 26, 2003

Respectfully submitted,

By   
Edward D. Steakley  
Registration No.: 47,964  
FULBRIGHT & JAWORSKI L.L.P.  
1301 McKinney, Suite 5100  
Houston, Texas 77010-3095  
(713) 651-5423  
(713) 651-5246 (Fax)  
Attorneys for Applicant